

06-17-05

PATENT

Customer No. 22,852

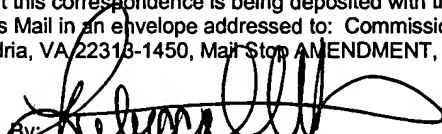
Attorney Docket No. 07451.0005-04

Intertrust Ref. No. IT-7.2.1 (US)



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By: 
Rebecca M. Whitelock

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)	
)	
GINTER et al.)	Group Art Unit: 3624
)	
Application No.: 10/727,324)	Examiner: Not yet assigned
)	
Filed: December 2, 2003)	
)	Confirmation No.: 6224
For: TRUSTED INFRASTRUCTURE)	
SUPPORT SYSTEMS, METHODS)	
AND TECHNIQUES FOR SECURE)	
ELECTRONIC COMMERCE)	
TRANSACTION)	

Mail Stop - AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INFORMATION DISCLOSURE STATEMENT UNDER 37 C.F.R. § 1.97(b)

Pursuant to 37 C.F.R. §§ 1.56 and 1.97(b), Applicants bring to the attention of the Examiner the documents on the attached listing. This Information Disclosure Statement is being filed before the mailing date of a first Office Action on the merits for the above-referenced application.

Each document listed in this Information Disclosure Statement was first cited in a communication from the Japanese Patent Office in a counterpart foreign application.

Copies of the listed foreign and non-patent literature documents are attached. English language translations, summaries or abstracts of most of the non-English documents are attached to each respective reference. Additionally, no English language translations or abstracts are available for two of the cited references, C1 and C6 on the attached form PTO/SB/08. In lieu of a statement of relevance or translation of these references, English language versions of two Office Actions from the Japanese Patent Office citing these references and setting forth the relevance thereof are enclosed.

Applicants respectfully request that the Examiner consider the listed documents and indicate that they were considered by making appropriate notations on the attached form.

This submission does not represent that a search has been made or that no better art exists and does not constitute an admission that each or all of the listed documents are material or constitute "prior art." If the Examiner applies any of the documents as prior art against any claim in the application and Applicants determine that the cited document do not constitute "prior art" under United States law, Applicants reserve the right to present to the office the relevant facts and law regarding the appropriate status of such documents.

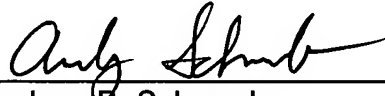
Applicants further reserve the right to take appropriate action to establish the patentability of the disclosed invention over the listed documents, should one or more of the documents be applied against the claims of the present application.

If there is any fee due in connection with the filing of this Statement, please
charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 15, 2005

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NOTICE OF REASONS FOR REJECTION

Patent Application No.: 2003-116576

Drafting Date: February 25, 2005

Patent Office Examiner: T. Miyaji

Attorney for Patent Applicant: T. Ishida (and 4 others)

Applicable Provisions: Article 29, the body; Article 29, paragraph 2; Article 36; Article 37

It is deemed that the present application should be rejected for the following reasons. An argument, if any, should be submitted within three months from the mailing date of this notice.

REASONS

A. The present application does not satisfy the requirements prescribed in Article 37 of the Patent Law on the following points.

Note

The reference: "Account Processing in Right Management Mechanism for Super Distribution" written by Shinichi Ueki, etc., Study Report of Information Processing Societies, 90-IS-27, January 16, 1990, Vol. 90, No. 1, page 1-10, published before the filing date (February 13, 1995) of the application from which the priority of the present invention was claimed, discloses the art in which an encrypted S software (corresponding to "resource" of the present application) with a measuring program (corresponding to "control" of the present application) is

received from a plurality of entities such as owners of copyright, distributors, etc., and is used in a S computing machine (corresponding to "secure operating environment" of the present application), to send a payment file of audit information to a payment center.

Accordingly, from the description of the reference, it is deemed that a new object of the invention in claim 1 (referred to as "specific invention" hereinafter) of the present application and the significant features recited in the claim are as follows:

Object: To securely send to entities in accordance with the control received from two different entities, audit information concerning use of resource.

Significant Features: To receive a first control from a first entity and receive a second control from a second entity different from said first entity, and to securely send to said first entity in accordance with said first control, first audit information concerning use of resource and securely send to said second entity in accordance with said second control, second audit information concerning use of said resource that is at least partially different from said first audit information.

However, neither the invention in claim 2 wherein two control alternatives are received from one entity and one of the control alternatives is selected, nor the invention in claims 3-33 of the present application wherein "control information" to at least partially govern use of resource

is received from entities and is selected, achieve the above-mentioned object or have the above-mentioned significant features. Consequently, the object and the significant features of the specific invention are different from those of the inventions in claims 2-33 and the requirements prescribed in Article 37, paragraph 1, items 1 and 2 of the Patent Law are not satisfied.

Also, the specific invention and the inventions in claims 2-33 do not satisfy the requirements prescribed in Article 37, paragraph 1, items 3 through 5 of the Patent Law.

Therefore, the inventions in claims 2-33 of the present application have no relationship, as prescribed in any item of Article 37, paragraph 1, with the specific invention and, thus, the specific invention and the inventions in claims 2-33 cannot be included in a single patent application.

This application violates the provisions prescribed in Article 37 of the Patent Law and no examination on the requirements for novelty, inventive step, etc., has been made for the inventions in claims other than claim 1.

B. The description of the claims of this application does not satisfy the requirements prescribed in Article 36, paragraph 6, item 2 of the Patent Law on the following points.

Note

(1) Regarding the descriptions of "secure operating environment", "securely receiving", "securing sending" in claim 1 of the present application, it is not technically understandable as to what the "secure operating environment" refers to, as to how the control is received and as to how the audit information is sent and, thus, the invention in claim 1 is indefinite.

C. The description in claim 1 of this application does not satisfy the requirements prescribed in Article 29, paragraph 1, the body of the Patent Law on the following points and, thus, the application is unpatentable.

Note

It can be assumed that, in the method according to claim 1 of the present application, the processes to use and audit a resource are performed under the secure operating environment and the object is achieved by the use of a "computer".

However, regarding each step of the method which achieves the object, how the hardware resource is used to perform the processes in each step is not described directly or indirectly. Accordingly, the means for achieving the object by which a law of nature is utilized resides only in "using a computer".

Therefore, the method according to claim 1 of this application is not deemed an "invention" defined by the Patent Law and does not satisfy the requirements prescribed in Article 29, paragraph 1, the body of the Patent Law.

D. The invention described in claim 1 of this application

(even if deemed as "invention" defined by the Patent Law) is deemed one which could easily have been made, prior to the filing of the present application, by a person with ordinary skill in the art to which the invention pertains, on the basis of the invention described in the following publication distributed in Japan or a foreign country prior to the filing of the present application and, therefore, is unpatentable under the provisions of Article 29, paragraph 2, of the Patent Law.

Note

Reference 1: Shinichi Ueki, Yasuhiro Otaki and Ryoichi Mori, "Account Processing in Right Management Mechanism for Super Distribution", Study Report of Information Processing Societies, 90-IS-27, January 16, 1990, Vol. 90, No. 1, page 1-10

REMARKS

No inventive step is necessary for an artisan to complete the invention according to claim 1 of this application, by determining that the payment file is sent not to the center but to the entity from which the S computing machine receives the S software, in the art disclosed in Reference 1 (discussed in the Reason A).

If another reason for rejection is found, another notice of reasons for rejection will be issued.

Attention should be paid to the following points if, within the due term for submitting an argument, an amendment is submitted to amend the specification or the drawings of this application.

(1) If the specification or the claims is amended, the amended portion should be underlined (Form No. 13, Remark 6 of Enforcement Regulations under the Patent Law).

(2) Matters which can be added by an amendment should remain within the scope of the features disclosed in the specification, claims or drawings originally attached to the application. When submitting an amendment, corresponding portions (paragraph no., drawing no.) of the specification, claims or drawings originally attached to the application that support each matter amended in the amendment should be clearly specified by an argument.

(If an amendment is based on the description of the claims now on file, corresponding portions of the detailed explanation of the invention of the original specification and the drawings should be clearly specified.)

(3) The invention according to amended claims should not be identical to the invention according to the claims of Application No. 8-526318 from which the present divisional application was derived and of each divisional application from Application No. 8-526318.

For each of Application No. 8-526318 and its divisional applications, i.e., Application No. 2003-102185, Application No. 2003-117920 and Application No. 2003-124706, a notice of reasons for rejection was drafted on the same date as this notice.

Regarding the record of results of prior art search,

see the references cited in the notices and the references listed in the columns of Record of Results of Prior Art Search, of the notices.

(4) This application is a divisional application from the international application dated February 13, 1996 and a "computer program" itself and a "machine-readable recording medium that stores a computer program" cannot be protected by "invention" under the Patent Law.

Record of Results of Prior Art Search

- Searched Field: IPC 7th Issue G06F15/00, G06F17/60
G06F1/00, G06F11/00

DB used in the search

- Prior Art

A: Naoya Trii, etc., "System Architecture for Super Distribution", Technical Research Report of Institute of Electronics, Information and Communication Engineers, September 21, 1994, Vol. 94, No. 240 (ISEC94-21), page 59-66

B. Kazunori Seki, etc., "Proposal for New Software Distribution System Using a Secret Code", Research Report of Information Processing Societies, July 20, 1993, Vol. 93, No. 64, (93-IS-45), page 19-28

C. Kokai (Jpn. Unexamined Patent Publication) No. 1-68853

D. Kokai No. 1-248891

E: John R. Garrett, Patrice A. Lyons,
"Toward an Electronic Copyright Management System",
Journal of The American Society for Information
Science, Vol. 44, No. 8, page 468-473, 1993

F. Moshe Rozenblit, "SECURE SOFTWARE DISTRIBUTION", IEEE

Network Operations and Management Symposium,
1994-02-17, Vol. 2, page 486-496

- G. Minoru Terada, "Exhausting Software", bit, Kyoritsu
Shuppan Co., Ltd., October 1, 1994, Vol. 26, No. 10,
page 12-18

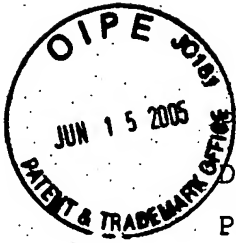
(The above references are the same as those for
Application No. 8-526318.)

This record of results of prior art search does not
constitute reasons for rejection.

For any inquiries or interviews regarding this notice
of reasons for the rejection, please contact the following:
Patent Examination Division 4 for Data Processing, Miyaji
Tel. 03-3581-1101, Ext. 3545
Fax. 03-3501-0737

Attorney's Reference No.: B035404, Mailing No.: 072746,
Mailing Date: March 1, 2005

NOTICE OF REASONS FOR REJECTION



Patent Application No.: 2003-124706

Drafting Date: February 25, 2005

Patent Office Examiner: T. Miyaji

Attorney for Patent Applicant: T. Ishida (and 4 others)

Applicable Provisions: Article 29, paragraph 1; Article 29, paragraph 2; Article 36; Article 37

It is deemed that the present application should be rejected for the following reasons. An argument, if any, should be submitted within three months from the mailing date of this notice.

REASONS

A. This application does not satisfy the requirements prescribed in Article 37 of the Patent Law on the following points.

Note

Kokai (Jpn. Unexamined Patent Publication) No. 6-152585 published prior to the filing of the priority application of the present application discloses the art in which a main device 13 (corresponding to "first device" of the present application) receives digital information and stores the same in a recording medium, and key information (corresponding to "information associated with the digital file" of the present application) is input and stored. The main device 13 determines whether the digital information may be copied on a slave device 14 (corresponding to "second device" of the present application) based on the

licensed number of copies (corresponding to "one control" of the present application) in the key information. If the copying is authorized, the digital information is copied on the slave device and the image, sound, etc., can be reproduced (corresponding to "rendering" of the present application) in the slave device.

The copying of the information on another device is usually carried out by copying a portion of the information and, thereafter, transferring the same to the other device and storing the same in a memory of the other device.

When the art disclosed in the above reference is compared to the invention according to claim 1 of the present application, no remarkable difference between the two is found. Accordingly, a new object of the invention according to claim 1 of the present application (referred to as "specific invention" hereinafter) and the significant features of the claim cannot be found.

Therefore, neither the object nor the significant features of the invention in claim 1 are identical to those of the inventions in claims 2 through 44 and the invention in claim 1 and the inventions in claims 2 through 44 do not satisfy the requirements prescribed in Article 37, paragraph 1, items 1 and 2 of the Patent Law.

Further, the invention in claim 1 and the inventions in claims 2 through 44 do not satisfy the requirements prescribed in Article 37, paragraph 1, items 3 through 5 of the Patent Law.

As discussed above, the invention in claim 1 and the inventions in claims 2 through 44 of the present

application have no relationship, as prescribed in any item of Article 37, paragraph 1 of the Patent Law, and cannot be included in a single patent application.

As the present application does not satisfy the requirements prescribed in Article 37 of the Patent Law, no examination for the patentability requirements, such as novelty, inventive step, etc., has been made for the claims other than claim 1.

B. The description of the claims of the present application does not satisfy the requirements prescribed in Article 36, paragraph 6, item 2 of the Patent Law on the following points.

Note

(1) Regarding the descriptions of "in a secure memory" and "secure database" in claim 1, it is indefinite technically and terminologically, as to what types of "memory" and "database" are referred to as the "secure memory" and "secure database", respectively. Consequently, the invention claimed in claim 1 cannot be clearly understood.

Therefore, the invention according to claim 1 is indefinite.

C. The invention described in claim 1 of this application is deemed the invention described in the following publication distributed in Japan or a foreign country prior to the filing of the patent application and, therefore, is unpatentable under the provisions of Article 29, paragraph

1, item 3, of the Patent Law.

Note

Reference 1: Kokai No. 6-152585

D. The invention described in claim 1 of this application is deemed one which could easily have been made, prior to the filing of the patent application, by a person with ordinary skill in the art to which the invention pertains, on the basis of the invention described in the following publication distributed in Japan or a foreign country prior to the filing of the present application and, therefore, is unpatentable under the provisions of Article 29, paragraph 2, of the Patent Law.

Note

Reference 1: Kokai No. 6-152585

REMARKS

Regarding the reasons "C" and "D";

As mentioned in the reason "A", the invention according to claim 1 of the present application is substantially identical to that disclosed in Reference 1.

If another reason for rejection is found, another notice of reasons for rejection will be issued.

Attention should be paid to the following points if, within the due term for submitting an argument, an amendment is submitted to amend the specification or the drawings of this application.

(1) If the specification or the claims is amended, the

amended portion should be underlined (Form No. 13, Remark 6 of Enforcement Regulations under the Patent Law).

(2) Matters which can be added by an amendment should remain within the scope of the features disclosed in the specification, claims or drawings originally attached to the application. When submitting an amendment, corresponding portions (paragraph no., drawing no.) of the specification, claims or drawings originally attached to the application that support each matter amended in the amendment should be clearly specified by an argument.

(If an amendment is based on the description of the claims now on file, corresponding portions of the detailed explanation of the invention of the original specification and the drawings should be clearly specified.)

(3) The invention according to amended claims should not be identical to the invention according to the claims of Application No. 8-526318 from which the present divisional application was derived and of each divisional application from Application No. 8-526318.

For each of Application No. 8-526318 and its divisional applications, i.e., Application No. 2003-102185, Application No. 2003-117920 and Application No. 2003-124706, a notice of reasons for rejection was drafted on the same date as this notice.

Regarding the record of results of prior art search, see the references cited in the notices and the references listed in the columns of Record of Results of Prior Art Search, of the notices.

(4) This application is a divisional application from the international application dated February 13, 1996 and a

Attorney's Reference No.: B035404, Mailing No.: 072746,
Mailing Date: March 1, 2005

"computer program" itself and a "machine-readable recording medium that stores a computer program" cannot be protected by "invention" under the Patent Law.

Record of Results of Prior Art Search

- Searched Field: IPC 7th Issue G06F12/14, G06F17/60
G06F1/00

DB used in the search

- Prior Art

A: Kokai No. 63-129564

B: Kokai No. 61-121145

C: "Information Society Facing a Turning Point,
Information Flood, How to Stand Against Flood of Copies",
Nikkei Byte, No. 92, November, 1991, pages 316-319

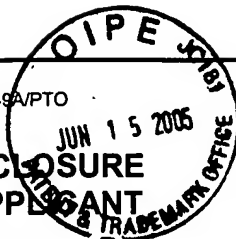
D: Kokai No. 7-319681

(The above references are the same as those for
Application No. 2003-102185.)

This record of results of prior art search does not
constitute reasons for rejection.

For any inquiries or interviews regarding this notice
of reasons for the rejection, please contact the following:
Patent Examination Division 4 for Data Processing, Miyaji
Tel. 03-3581-1101, Ext. 3545
Fax. 03-3501-0737

IDS Form PTO/SB/08: Substitute for form 1449A/PTO				Complete if Known	
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)				Application Number	10/727,324
				Filing Date	December 2, 2003
				First Named Inventor	GINTER et al.
				Art Unit	3624
				Examiner Name	Not yet assigned
Sheet	1	of	2	Attorney Docket Number	07451.0005-04000



Note: Submission of copies of U.S. Patents and published U.S. Patent Applications is not required.

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	Translation ⁴
		Country Code ¹ Number ² Kind Code ³ (if known)				
		JP 01 248891 A	10-04-1989			Abstract only
		JP 01 296363 A	11-29-1989			Abstract only
		JP 01 68853 A	03-14-1989			Abstract only
		JP 04 117548 A	04-17-1992			Abstract only
		JP 04 504794	08-20-1992			Abstract only
		JP 05 173892 A	07-13-1993			Abstract only
		JP 05 258463 A	10-08-1993			Abstract only
		JP 06 152585 A	05-31-1994			Abstract only
		JP 06 161719 A	06-10-1994			Abstract only
		JP 06 250924	09-09-1994			Abstract only
		JP 06 501120	01-27-1994			Abstract only
		JP 07 319681 A	12-08-1995			Abstract only
		JP 61 121145 A	06-09-1986			Abstract only
		JP 63 129564 A	06-01-1988			Abstract only
		JP 63 289646 A	11-28-1988			Abstract only

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	Translation ⁶
	C1	"Information Society Facing a Turning Point, Information Flood, How to Stand Against Flood of Copies," <i>Nikkei Byte</i> , 92:316-319, 1991.	Unavailable
	C2	GARRETT et al., "Toward an electronic Copyright Management System," <i>J. of the Amer. Soc. for Info.</i> , 44(8):468-473, 1993.	Yes
	C3	KOZUKA et al., "Electronic Magazine Editing Software for 3DO," <i>National Technical Report, Matsushita Electric Industrial Co., Ltd.</i> , 40(6):88-97, 1994.	Abstract only

IDS Form PTO/SB/08: Substitute for form 1449A/PTO			Complete if Known		
INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)			<i>Application Number</i>	10/727,324	
			<i>Filing Date</i>	December 2, 2003	
			<i>First Named Inventor</i>	GINTER et al.	
			<i>Art Unit</i>	3624	
			<i>Examiner Name</i>	Not yet assigned	
Sheet	2	of	2	<i>Attorney Docket Number</i>	07451.0005-04000

NON PATENT LITERATURE DOCUMENTS			
	C4	ROZENBLIT, Moshe, "Secure Software Distribution," <i>IEEE Network Operations and Management Symposium</i> , 2:486-496, 1994.	Yes
	C5	SEKI et al., "A Proposal for New Software Distribution System Using a Secret Code," <i>Research Report of Information Processing Societies</i> , 93(64):19-28, 1993.	Abstract only
	C6	TERADA, Minoru, "Exhausting Software," <i>bit</i> , Kyoritsu Shuppan Co., Ltd., 26(10):12-18, 1994.	Unavailable
	C7	TORII et al., "System Architecture for Super Distribution," <i>Technical Research Report of Institute of Electronics, Information and Communication Engineers</i> , 94(240):59-66, 1994.	Abstract only
	C8	UEKI et al., "Accounting Processing in Right Management Mechanism for Super Distribution," <i>Study Report of Information Processing Societies</i> , 90(1):1-10, 1990.	Abstract only

Examiner Signature		Date Considered	
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EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.